

REMARKS

The following rejections under 35 U.S.C. 103 are responded to below.

Claims 1, 2, 7, 24, 25 and 30 stand rejected under 35 USC 103 as being unpatentable over U.S. Patent 4,989,673 to Sydansk in view of U.S. Patent No. 4,566,979 to Githens. The rejection is respectfully traversed.

8. Claims 1-4, 7, 24-27 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,377,760 to Merrill (herein referred to as Merrill '760) in view of Githens '979. The rejection is respectfully traversed.

Claims 1, 2, 5-13, 24, 25, and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,004,553 to House et al (herein referred to as House et al '553) in view of U.S. Patent 3,208,524 to Horner et al (herein referred to as Horner et al '524) and Githens '979. The rejection is respectfully traversed.

In response to all three of the above rejections, applicant wishes to direct attention to Board Decisions dated July 17, 2003 for Application S/N 09/307,544 (Appeal No. 2003-0604) in which very similar claims (well plug additive comprising a dry mixture of polymer/crosslinking agent/reinforcing material, and method of making) were rejected under

35 USC 103 over the same art of record (Horner et al., Githens, Sydansk, House et al., and Merrill). *See*, Exhibit A, July 17, 2003 Board Decision.

The Board stated that the common issue of the 103 rejections, "is whether the examiner has provided a proper factual foundation supporting her conclusion that one of ordinary skill in the art would have expected that the addition of inert solids (for example, sand), before activation with water, rather than after activation with water, would provide no substantial difference in results."

After finding a "lack of factual foundation," the Board reversed the 103 rejections.


Additionally, applicant respectfully directs attention to Board Decisions dated September 15, 2003 for Application S/N 09/296,216 (Appeal No. 2003-0515) in which very similar claims for a conformance additive were rejected under 35 USC 103 over the same art of record (Horner et al., Githens, Sydansk, House et al., and Merrill). In that Decision, the Board adopted the July 17, 2003 Board Decision. *See*, Exhibit B, September 15, 2003 Board Decision.

In view of the July 17, 2000 Board Decision, and further in view of the September 15, 2003 Board Decision adopting the July 17, 2003 Board Decision, applicant very respectfully requests allowance of all pending claims.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicants' attorney Mark Gilbreth at 713/667-1200.

Respectfully submitted,

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